



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,925	10/27/2003	Justin Monk	020375-043600US	5092

20350 7590 01/12/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

FISCHETTI, JOSEPH A

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	10/694,925	Applicant(s)	MONK, JUSTIN
Examiner	Joseph A. Fischetti	Art Unit	3627

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 October 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8-22 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Election/Restrictions

Applicant's argument regarding his telephonic election with traverse have been reviewed. Applicant argues that there is no undue burden on the examiner. However, there does exist quite a great burden because in the business method category, many additional items need to be covered which burden the tasks of the Examiner. For example, in the case of an allowance for a business methods case, a Reasons for Allowance must be made for each and every independent claim regardless of the lack of any separate or distinctness showing in the case. Applicant argues that claims 12 and 19 are linking claims, but these claims are simply product by product claims and do not link inventions, but rather are a mere short hand form of claims which otherwise would need to recite elements too cumbersome to incorporate into a single claim. In order to evidence the separate and distinctness of the restriction the following is added to the restriction:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a method of generating a request, classified in class 705, subclass 17.
- II. Claims 8-11 drawn to a method of processing, classified in class 705, subclass 53.
- III. Claims 12-22, drawn to a medium, classified in class 369, subclass 272.

The inventions are distinct, each from the other because:

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be

practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, invention III can be practiced by human intervention by causing a human to ask or request whether to use stored-value account or the credit account.

Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the invention II can be practice by human intervention by causing a human to instruct whether to use stored-value account or the credit account.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as an check bounce proofing method. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The restriction is now deemed FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blossom in view of Melchione et al.

Blossom discloses receiving at a POS device a cost (col. 3, line 28 card 10 may be used with a POS device which means a cost incurred) identifying an instrument associated with a stored-value account and a credit account (card 10), generating a request to select a distribution of the cost for the transaction among the stored-value and credit accounts for presentation at the point-of-sale device (Blossom discloses use of his card in a conventional card reader which "allows a user to select a card feature" the mere presentation of plural payment options is read as "generating a request" because the card wont function unless a selection is made; the step of transmitting the cost payment to the financial institution is deemed obvious and old to the card reader art.

However Blossom does not disclose the stored-value account and the credit account linked substantially contemporaneously with issuance of the instrument to the customer. But, Melchione et al. do disclose such a feature wherein the system "in a single session" links an account with plural sources (see Abstract of US '764 last

Art Unit: 3627

sentence "The system... for opening an account in a *single session* that is in communication with ..." It would be an obvious modification to Blossom to include the single session linking feature in order to link the stored value and the credit accounts at substantially the same time, the motivation being that this will keep both accounts as an option from the beginning of the card's use.

Re claim 2: Blossom discloses use of his card in a conventional card reader which "allows a user to select a card feature".

Re claims 3 and 4: official notice is taken with respect to which items are available for stored value points see e.g. frequent flyer points cannot be applied during holiday flights and some retail businesses restrict what can be purchased by credit cards e.g. stamps and lotto tics are cash based only.

RE claim 5: see col. 7 lines 6-9 for display of stored value.

Re claims 6 and 7: the step of applying only what is available in either credit or value to a cost and/or splitting same between them is deemed an old an obvious expedient.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

FINAL ARGUMENTS

Applicant's arguments have been fully considered but they are not persuasive.

Applicant's arguments more narrowly define the invention than the scope of his claims.

Applicant first argues that Blossom fails to teach:

"distributing the cost of a transaction among multiple accounts". This is not what is recited in the claims. What is recited is:

"... to select a distribution of the cost of the cost for the transaction among the stored-value account and the credit accounts.."

Applicant's arguments are based on a verb form of "distribute", but in the claim, only a noun form of distribute is used. In the claims, the verb used is, "to select" and not to distribute. This misuse of words is key to the rejection because as used in the claims, the method calls for a step of "selecting". In contrast, in the arguments, applicant has concluded that a selection has been made resulting in a distribution among plural accounts. In light of this distinction, Blossom answers this claim limitation because it gives the user the option to select between accounts, see col. 3, lines 15-18, col. 6 line 45, line 63, and based upon that selection, a distribution is made. Blossom meets this limitation by distributing 100% of the cost to one account and 0% to the other.

Second, Applicant argues that Melchione et al. fail to disclose "the stored values account and the credit account were linked substantially contemporaneously with issuance of the instrument to the customer". Applicant directs Applicant to the Abstract of Melchione et al. wherein it is disclosed to open an account and communicate, e.g.

link in a single session, to a central database, micromarketing centers, central customer information systems and branch systems. While this does not specifically call for the linking between stored-value account and the credit accounts, the ones identified by Melchione et al. would give enough of a basis to include a stored-value account and a credit accounts because Melchione et al. discusses see col. 4 lines 17 et seq. accommodating a wide variety of financial products which would included both stored-value account and the credit accounts.

Finally, Applicant seeks evidence of the Official Notice taken regarding to claims 6 and 7. Reference is hereby made to Carlisle et al in col. 3 lines 48, debiting plural accounts on a smart card is disclosed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to PRIMARY
EXAMINER Joseph A. Fischetti at telephone number (703) 305-0731.

975